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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,392	08/20/2004	Peter J Dronzek JR.	181-037	7246

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HEDMAN & COSTIGAN P.C.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
CHANG, VICTOR S	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/505,392	DRONZEK ET AL.	
	Examiner	Art Unit	
	Victor S. Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-53* is/are pending in the application.

4a) Of the above claim(s) *12-53* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 August 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/20/04, 5/2/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicants' election without traverse of Group I in the reply filed on 5/2/2006 is acknowledged. Further, Applicants have also elected species of Fig. 1, and identified claims 1-11 as reading on the elected species. In summary, claims 12-53 are withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, it is unclear what is the meaning of the symbol "#" at line 2 of claim 4, nor is there a definition in the specification. Clarification or correction is requested.

Additionally, the term "obviously equivalent-treatment" at line 3 of claim 5 renders the scope of claim indefinite, because it is not clear what is being included or excluded. Appropriate correction is necessary.

Finally, at lines 2-3 of claim 6, it is unclear to the Examiner what the term "measurable differential" is referring to? For the purpose of expediting the prosecution, it is presumed to be a measurable difference in surface tension.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/505383. Although the conflicting claims are not identical, they are not patentably distinct from each other because they obviously read on each other as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 2, 5 and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by Fischer (US 6328340).

Fischer's invention relates to a form with detachable card. In Fig. 1, 1 denotes a form sheet made of paper. 2 denotes a piece of a substrate material, which comprises a substrate layer 21, a peeling adhesive layer 22, an outer layer 23 and a permanent pressure-sensitive adhesive layer 24. The substrate material is glued to the back of the form by means of the permanent pressure-sensitive adhesive layer 24. The two outer layers 23 and 41 are transparent plastic films, in particular polyester films (column 4, lines 46-57). A punching (die cut) runs all the way through the layers 41, 42, 1, 24, 23 and 22 and reaching down as far as the substrate layer 21 (column 4, line 62 to column 5, line 5). During detaching of the card 3, the peeling adhesive 22 is completely detached from the substrate layer 21 and stays with the card. The peeling adhesive layer 22 has to this extent a non-permanent adhesive effect with respect to the substrate material 21 and a permanent adhesive effect with respect to the material of

the outer layer 23 (column 5, lines 12-16). The different adhesive effect with respect to the substrate layer on the one hand (non-permanent) and the outer layer on the other hand (permanent) can in this case be achieved by suitable process control and/or different pretreatment of the film surfaces on both sides, such as by plasma, corona or flame treatment (column 3, lines 28-36). In particular, in the absence of evidence to the contrary, the Examiner takes Official notice that suitable surface treatment process control clearly encompasses time/speed of a process.

For claims 1, 2, 5 and 11, in the absence of a definition what is the scope of the term "pattern", it is the Examiner's position that Fischer's teaching of surface treatment reads on instant invention as claimed, and claims lack novelty.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 3, 4 and 6 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fischer (US 6328340).

The teachings of Fischer are again relied upon as set forth above.

For claims 3, 4 and 6, Fischer is silent about the thickness of polyester film layer and the weight basis of the paper stock, and difference in surface tension after treatment. Nonetheless, since Fischer clearly teaches the same subject matter (card

intermediate) as the instant invention, in the absence of evidence to the contrary, it is the Examiner's position that suitable aforementioned limitations are either anticipated by Fischer, or obviously provided by practicing the invention of prior art. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

10. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 6328340) in view of Hoffman (US 4879430).

The teachings of Fischer are again relied upon as set forth above.

For claims 7-9, Fischer lacks a teaching about the percentage of treated area and the geometric pattern of surface treatment. However, it is noted that Hoffman's invention id directed to a patterned adherent film structure. Hoffman teaches that a web of plastic wherein one surface layer thereof has been subjected to selective pattern of corona discharge treatment such that the face of one surface of the web has a pattern therein. This pattern is characterized by selective corona discharge treatment in some areas. Preferably, the pattern has relatively small repeating units (column 2, lines 35-41). Further, the configurations associated with a treatment pattern can be used to enhance the increased bond strengths achieved (column 3, lines 32-34). As such, in the absence of unexpected results, since Fischer does expressly teach that the different adhesive effect with respect to the substrate layer on the one hand (non-permanent) and the outer layer on the other hand (permanent) can in this case be achieved by

suitable process control and/or different pretreatment of the film surfaces on both sides, such as by corona treatment, etc., as set forth above, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify Fischer's surface treatment method with the a pattern taught by Hoffman, motivated by the desire to obtain desired differential adhesive effect at interfaces. Regarding the percentage of treated area, since the combined teachings of Fischer and Hoffman render the instant invention obvious, and having the same steps of use (in particular, detaching at the same interface), and the utility as such dictates there would be similar level of surface treatment, it is the Examiner's position that a suitable percentage of treated surface area is an obvious optimization to one skilled in the art of detachable cards. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Finally, it should be noted that in Fig. 4, Hoffman shows a treatment pattern of a polygon as claimed.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor S Chang
Examiner
Art Unit 1771

5/25/2006